

Additionally, the Examiner again rejected the Claims 1, 33-39, 41-44, 52 and 56 under § 102 as anticipated by DeBey.

Claims 1, 33-37, 49, 52, 54-56, and 58-59 were also again rejected under § 102 as anticipated by Lang.

Claims 1, 33, 36-37, 39-40, 51, 54-56 and 58-59 were rejected under § 102 as anticipated by what the Examiner called “Yoshiro et al.” which is more correctly “Yoshio et al.”

The remainder of the claims were rejected under § 103 citing the above references in addition to Rovira, Official Notice, and Takahashi.

The rejections are all traversed.

Argument—Summary

The following deals with these issues in the following order:

1. The limitations “set of menus” and “database” are structural and cannot be disregarded by the Examiner. They do distinguish over the references.
2. DeBey does not anticipate or make obvious the claims.
3. Lang does not anticipate or make obvious the claims.
4. Yoshio et al. does not anticipate or make obvious the claims at least because Yoshio et al. is non-enabling and hence does not meet the requirements for a reference.

“Set of Menus” and “Database” are Structural

The Examiner at page 2 of his Action indicates that he is ignoring limitations in the present claims as being “non-functional descriptive material” that cannot distinguish the claimed apparatus over the references. The Examiner characterizes both the term “set of menus” and the term “storing data in the received broadcast signals in a database” as being such limitations. The Examiner cites *Ex Parte Masham* and *In re Danly* in support of this position. It is respectfully

submitted that the Examiner has misconstrued the law, has not complied with MPEP, and has also not properly applied these cases.

First, the Examiner cites *In re Danly*, 263 F.2d 844 (C.C.P.A. 1959) for the rule that an apparatus must distinguish over a reference in terms of structure rather than merely function. That rule, if it is one, of *Danly* does not govern this case, however, because, first, the limitations here are not purely functional, like those that failed in *Danly*, but contain additional structures that distinguish over the references, and second, *Danly* permits structure to be implied from recited functions and so to distinguish over prior art.

The claims *Danly* found wanting were to a power press structure in which tie rods were insulated from the frame “such that alternating current may be passed through the tie rod to heat the same.” The cited references disclosed press structures with insulated tie rods, but not passing an alternating current through them. The court noted that “the quoted expression does not constitute a structural limitation since an alternating current *may* be passed through any tie rod which is insulated from the press frame.” 263 F.2d at 847 (original emphasis). As a result, it added nothing to the press structure already recited and left the claim indistinguishable from prior art.

In contrast, the court upheld other apparatus claims that contained functional limitations that were less equivocal and *did* serve to distinguish the prior art:

[Applicant] has used such phrases as “for holding” and “for insulating” throughout the appealed claims with the obvious intention of limiting them to actual performance of the stated functions, as distinguished from mere possibility of such performance, and no objection to such use has been made by the Patent Office tribunals, nor has any rejection of the appealed claims been based on indefiniteness or inferential recitation. Under such circumstances, we think claims 3 through 7 should be construed as being limited to an apparatus in which alternating

current is actually applied to the tie rods, and our allowance of those claims is based on that interpretation.” *Ibid.*

The real rule of *Danly* is that functions, when tied to structure in the claims, are permissible limitations and can distinguish over prior art.

In the present case, Applicant respectfully submits that the terms “set of menus” and “database” are in fact understood in the art as structural elements, not functions. See First Declaration, paragraph 11. Note the Declarant’s extensive expertise in the television/video/communications fields, see Exhibit 1 to First Declaration. The Declarant’s experience in working with many others in these fields over the years gives him authority for indicating meanings of these terms to those skilled in these fields. As will be shown, these structural elements required by the claims distinguish over the cited references.

However, even if the phrases that contain “database” and “set of menus” were regarded as functional because they use words such as “for storing” “for providing,” and “for accepting,” nevertheless, the intention here is no less obvious than where similar phrases were used in *Danly* to limit the claims to the actual performance of the stated functions. Thus, for example, in claim 1, “a memory . . . for storing data in the received broadcast signals in a database” is not satisfied by just any memory, so long as it *could* conceivably store the data in a database; instead the claim requires that the data is *actually* stored in a database, that is, that the apparatus contains a database. As in *Danly*, these phrases thereby distinguish over the prior art.

The Examiner also cited *Ex Parte Masham* 2 USPQ 2d 1647 (Board of Patent Appeals and Interferences 1987) for the rule that a claim limitation directed to how the apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all structural limitations of the claim. The actual statement in *Masham* is:

At any rate, a recitation with respect to the material intended to be worked upon by a claimed apparatus does not impose any structural limitations upon the claimed apparatus which differentiates it from a prior art apparatus satisfying the structural limitations of that claimed.

*Masham* continues:

Similarly, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of that claim.

That is not the case here. The present claims do not refer to the workpiece being operated on or merely the manner in which the apparatus is used. Instead, “database” and “set of menus” are directed to structures in which an act is carried out by the apparatus.

Moreover, even if *arguendo* the present claims included functional limitations, the Examiner is not permitted to ignore them. The first paragraph of MPEP 2173.05(g) states “Functional language does not, in and of itself, render a claim improper.” Instead “A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the cited element, ingredient or step.”

This is not to concede that the present claims include functional limitations, but even if they did this is not problematic under the law or MPEP.

See also MPEP 2114 indicating that apparatus claims must be structurally distinguishable from the prior art. However, as pointed out above, the cases relied upon by the Examiner are not the same in terms of the facts as the present claims. For instance, as stated in MPEP 2114, one may find anticipation of a claimed apparatus because the claims at issue were found to be inherent in the prior art reference. That is clearly not the case here.

As pointed out above, the Examiner is required to give full patentable weight to all limitations in the claims. The present claims do not include “non-functional elements” or merely descriptive elements.

Hence the mere fact that a reference might include, for instance, a tuner, memory, user interface controller and speech subsystem does not result in meeting the present claims, as set forth in detail below discussing the particular rejections.

DeBey Does Not Meet Claims

Specifically, it is clear that DeBey does not have any menus or any database, or any set of menus and does not use menus to select items stored in the database.

See the enclosed First Declaration, paragraphs 4-9 establishing this. DeBey apparently only stores part of one program at a time in his memory, or he stores a single data packet of each of several programs. See First Declaration, paragraphs 5-7. In any case, there is no menu and there is no database and no selection from the stored items using the menu. See First Declaration, paragraphs 8-9.

Hence clearly DeBey fails to disclose or suggest at least (see Claim 1) “storing data in the received broadcast signal in a database;” and “a set of menus describing the database” and “accepting selections from the set of menus” and further, “selecting data from the database in response to the accepted selections.” Moreover, since DeBey has no need for a database or menu or menus given the nature of its very limited storage, it does not suggest anything that would render obvious the present claims, see First Declaration, paragraph 10.

Independent Claim 58 recites similar aspects as Claim 1 and similarly distinguishes over DeBey.

Hence each of present independent Claims 1 and 58, and all claims dependent therefrom, distinguish over DeBey.

Lang Does Not Meet Claims

Lang is deficient in essentially the same ways as DeBey. See the enclosed First Declaration paragraphs 12-14.

As set forth in the First Declaration, paragraph 12, the Lang device is an improved video cassette recorder (VCR). Lang does not disclose a menu describing the stored data, much less a set of menus. See First Declaration, paragraph 13. There is a single use of the term “menu” in Lang at col. 6, lines 63-68. However, this is not a menu that describes the content of the stored data. Instead Lang is merely providing a display described as a “menu” which shows a list of desired “frame numbers” stored on the VCR tape. See First Declaration, paragraph 12. There is no similarity between the frame numbers in Lang and the menus in the present claims. It is clear that “frame numbers” are clearly not a list of items descriptive of the content of the database, any more than a list of the page numbers of a book indicates what is written on them. Instead the Lang frame numbers merely represent frames of a particular stored program. Further, Lang does not describe how the stored program segments themselves are identified in his storage system.

Hence in Lang’s apparatus there is no database, no menu to select programs, no set of menus, and no selection from stored programs using the set of menus, see First Declaration paragraph 13.

Hence Lang also does not meet the present claims nor does Lang render them obvious, see First Declaration, paragraph 14.

Hence each of present independent Claims 1 and 58, and all claims dependent therefrom, distinguish over Lang.

Yoshio et al. Status

It is respectfully submitted that the Yoshio et al. reference, also cited by the Examiner as meeting the present independent claims, does not anticipate the claims as a matter of law because, inter alia, Yoshio et al. is not an enabling disclosure. See the enclosed Second Declaration paragraphs 3, 4 and 6. Yoshio et al. is a published unexamined Japanese patent application (Kokai). See Second Declaration, paragraph 5. Japanese patent attorneys representing the assignee of this application have verified to the undersigned that the Yoshio et al. application was never even examined. As the Examiner knows, in Japan a request for examination must be filed by the applicant or the application is not examined. According to the Japanese Patent Office database, the Yoshio et al. Japanese patent application was never examined and is deemed to have been withdrawn. No official action was ever issued nor any response filed. It is a matter of public record that no patent in Japan or elsewhere ever issued from or claiming priority to Yoshio et al. Clearly, no patent will ever issue from the Yoshio et al. application now. It is not believed that any foreign counterpart applications to Yoshio et al. were ever even filed.

Lack of Enablement in a Reference—Law

An applicant for a patent bears the burden of introducing evidence that a reference applied by the USPTO lacks an enabling disclosure. Evidence to such effect may be introduced into the record by means of an affidavit or declaration pursuant to 37 CFR § 1.132, as has been done here.

A prior art publication must be enabling in order to defeat novelty, that is to be anticipating. See, for instance, *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 62 USPQ 2d 11865 (Fed. Cir. 2002). In order to anticipate, the reference must enable one of

skill in the art to make and use the claimed invention. In other words, to be prior art under § 102, a reference must put the anticipating subject matter at issue in the possession of the public through an enabling disclosure. See *Akzo NV v. U. S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986). Further, a prior art publication must contain within its four corners sufficient description to enable a person of ordinary skill in the art to make the invention without an unreasonable amount of experimentation. See for instance, *Advanced Display Systems, Inc. v. Kent State University*, 212 F.3d 1272, 1282, 54 USPQ 2d 1673, 1679 (Fed. Cir. 2000).

If the USPTO cites a prior art disclosure that anticipates the claims, the burden of proof shifts to the applicant to rebut a presumption that the disclosure is operable. If the applicant makes a *prima facie* case that the prior art reference is inoperable, the burden shifts back to the PTO to show through prior art or otherwise that the reference is enabling. See *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980).

Yoshio et al Is Not Enabling

Yoshio et al., not being an issued patent, does not enjoy any presumption of validity. Moreover, since Yoshio et al. is only a Kokai and not an issued patent, much less a U.S. issued patent, there is no presumption that it is operable and/or enabling. Even if it were, by filing the enclosed Second Declaration Applicant has rebutted any presumption that the Yoshio et al. disclosure is operable.

As established in the Second Declaration, paragraph 6, the Yoshio et al. disclosure is very sketchy in terms of technical detail. The Yoshio et al. figures and text are lacking in terms of the internal components and operation of the apparatus except for the very general disclosure that it



is based on an optical recording disc drive and receives a television signal. See Second Declaration, paragraphs 3-4.

The Yoshio et al. disclosure is of user functionality, not how the actual apparatus is built or operates. As established in the Second Declaration, the description of Yoshio et al. is more a wish list of desired functionality than enabling of an actual apparatus, see Declaration paragraph 6.

As a result, putting aside whether Yoshio et al. discloses what is recited in the present claims, the absence of enablement and operability of the Yoshio et al. apparatus removes it from being available to cite against the present claims for anticipation.

#### Obviousness

Although the Examiner did not reject the present independent claims as being obvious, it is respectfully submitted that the claims distinguish over the present references even in combination with other references. This is because, at least, DeBey, Lang and Yoshio et al lack essential elements which are not made good by the other references.

#### Conclusion

It is respectfully submitted that, first, all limitations of the present claims are relevant and entitled to patentable weight and should be given same. Moreover, the present claims clearly are not anticipated or made obvious by DeBey or Lang. Further, the Yoshio et al. rejection is not appropriate since Yoshio et al. is not enabling. (This is not to concede that even if Yoshio et al. were enabling it would anticipate.)

Therefore, it is requested that the Examiner reconsider all of the rejections, withdraw them, and pass this case to issue with all pending claims allowed.

This paper is accompanied by a request for continued examination, as a result this Response and the two Declarations are entitled to entry. If the Examiner contemplates action other than withdrawing all rejections and passing this case to issue with all claims allowed, he is requested to contact the undersigned at the telephone number given below.

In the event that the USPTO determines that an extension and/or other relief is required in addition to the request for time extension enclosed herein, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this paper to Deposit Account No. 03-1952 referencing Docket No. 54922-2000101.

Respectfully submitted,



---

Norman R. Klivans  
Registration No. 33,003  
MORRISON & FOERSTER LLP  
755 Page Mill Road  
Palo Alto, California 94304-1018  
(650) 813-5850

Dated: March 8, 2006